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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,584	08/16/2006	Stefan Kerpe	4029 0140US	9930
29894 7590 11/10/2008 DREISS, FUHLENDORF, STEIMLE & BECKER POSTFACH 10 37 62 D-70032 STUTTGART, GERMANY			EXAMINER LESLIE, MICHAEL S	
			ART UNIT 3745	PAPER NUMBER
			MAIL DATE 11/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/589,584	Applicant(s) KERPE ET AL.	
	Examiner MICHAEL LESLIE	Art Unit 3745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/16/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the spindle rod disposed on the piston (claim 15), the spindle nut driven by the motor (claim 15), the mechanical coupling means in the form of a toothed rack and pinion (claim 18), the rotary coupling (claim 19), the motor disposed within the housing (claim 22), and a regulation and/or control unit (claims 23, 24) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "high transmission ratio" in claim 25 is a relative term which renders the claim indefinite. The term "high transmission ratio" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification has not defined what is considered to be a "high transmission ratio". .

Claims 26-29 are indefinite because they recite a method of operation, but do not set forth any method steps.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-17 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Yuda, Jr. et al ('Yuda') (6116139).

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Yuda discloses a rotary or pivotal unit having a housing (B), a cylinder disposed in the housing, a working piston (11) disposed in the cylinder, a rotary coupling (C) disposed in the housing and cooperating with the working piston and the pivoting member, wherein an axial motion of the working piston in the cylinder pivots the pivoting member, a motor (D), and means for mechanically coupling (10a, 20a) the working piston to the motor, wherein the motor decelerates and/or drives the working piston in an axial direction. Wherein the mechanical coupling means include a spindle nut (10) on the working piston and a spindle rod (20) driven by the motor, the spindle nut cooperates with and does not rotate with respect to the working piston, the spindle rod being disposed for rotation within the spindle nut, the spindle rod having a free end facing away from the working piston, which is connected to a drive shaft (51) of the motor for secure mutual rotation therewith, and a free end of the spindle rod facing away from the motor is disposed within the working piston, the working piston having a closed side facing away from the motor. The motor is flanged to the housing (e.g. Fig. 2) or disposed within the housing (e.g. Fig. 8), and the system further includes a regulation and/or control unit (30) to control the motor in dependence on a position of the working piston, a temporal change of position of the working piston, a respective pressure in the cylinder, and/or a temporal change of a respective pressure in the cylinder and to directly control pressure in pressure chambers of the cylinder when a limit load of the motor has been reached, to reduce a motor load, and/or to support motion of the working piston effected or controlled by the motor.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuda, Jr. et al ('Yuda') (6116139) in view of Skinner (5771635).

Yuda discloses a rotary or pivotal unit as described above, but does not teach that the mechanical coupling means includes a toothed rack on the piston and a pinion driven by the motor wherein the mechanical coupling means are not self locking.

Skinner discloses a rotary unit having a mechanical coupling means including a toothed rack (24) on the piston and a pinion (32) for driving an output wherein the mechanical coupling means is not self locking to allow loaded return.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the mechanical coupling means of Yuda to include a toothed rack on the piston and a pinion driven by the motor and to have the mechanical coupling means be non-self locking as taught by Skinner for the purpose of transmitting linear motion to rotary motion and rotary motion back to linear.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yuda, Jr. et al ('Yuda') (6116139) in view Henry (5577433).

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Yuda discloses a rotary or pivotal unit as described above, but does not teach that the mechanical coupling means includes a worm wheel rotated by the piston via a rotary coupling and a worm driven by the motor.

Henry discloses a rotary or pivotal unit having a mechanical coupling means including a worm wheel (83) rotated by the piston via rotary coupling and a worm (85) driven by a motor (91).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the mechanical coupling means of Yuda to include a worm wheel rotated by the piston via a rotary coupling and a worm driven by the motor as taught by Henry for the purpose of transmitting linear motion to rotary motion and rotary motion back to linear.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL LESLIE whose telephone number is (571)272-4819. The examiner can normally be reached on M-F 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Look can be reached on (571) 272-4820. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ML
November 7, 2008

/Michael Leslie/
Primary Examiner, Art Unit 3745